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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,311	03/01/2002	Daniel Lee Briley	10992014-1	8556

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

JABR, FADEY S

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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02/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/086,311	Applicant(s) BRILEY, DANIEL LEE	
	Examiner FADEY S. JABR	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims **21-23, 25-31, 33-38, 40-42** and **44** have been cancelled. Claims **1, 4-11** and **14-20** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments filed 21 December 2007 have been fully considered but they are not persuasive.
2. Applicant argues that Leon fails to disclose, suggest or even imply that the computer generates postage information. However, Examiner would first like to point out that both the Leon reference and the applicant's invention are concerned with the same issue, preventing postage fraud. Further, Examiner notes that in order for the invention of Leon to work, the information printed onto the label would have to be processed using the visible and non-visible ink. For example, Leon discloses if a particular area of the indicia is defined as including a barcode, that area may be designed to include a one-dimensional barcode, a two-dimensional barcode, cryptographic text, or some other elements...In a specific implementation, a list of available elements is formed for the markets targeted for the device. This list can include information such as a postage amount, graphics, time and date of the indicium creation, creation location, and other pertinent information....Elements in the indicia can be printed using various types of ink including visible and invisible inks, fluorescent and non-fluorescent inks, or any combination thereof. The ink used for some or all elements can be visible to the human eye. The ink can also be invisible to the human eye under white light and become apparent only under

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light of specified wavelength(s) such as UV light...(C. 8, line 51 - C. 9, line 25). Therefore, Leon discloses processing visible and invisible ink to print elements, e.g., postage amount, graphics, time and date, and other pertinent information.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **1, 4-11** and **14-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Patent No. 6,701,304 B2, hereinafter referred to as Leon.

As per **Claims 1 and 11**, Leon discloses a method for postage label authentication comprising:

- receiving the mail piece (C. 13, lines 18-33);
- scanning the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks, wherein the non-visible marks are scanned using an Ultra Violet (UV) light, and wherein the non-visible marks are also detectable by human eye using a UV light (C. 9, lines 14-25, C. 13, lines 18-42); and

- processing the visible mark information and the non-visible mark information to generate postage information for the mail piece (C. 2, lines 21-62, C. 3, lines 4-8, C. 8, line 51 – C. 9, line 25).

Leon fails to *explicitly* disclose that wherein the non-visible marks are also detectable by human eye using a UV light *for human confirmation of the non-visible marks*. However, Leon discloses the ink can also be invisible to the human eye under white light and become apparent only under light of specified wavelength(s) such as UV light (C. 9, lines 14-25). Further, the system of Leon is concerned with detecting the invisible ink in the indicia.

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App & Inter. 1987). Thus, the structural limitation of claims 1 and 11, including UV light is disclosed by Leon as described above. Also, as described above, the functional limitations in claims 1 and 11 do not distinguish the claimed apparatus from the prior art.

As per **Claims 4 and 14**, Leon further discloses processing the non-visible mark information to validate the postage evidence (C. 9, lines 23-25).

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As per **Claims 5 and 15**, Leon further discloses wherein the non-visible mark information comprises a key to the visible mark information (C. 11, line 63 – C. 12, line 7, C. 13, lines 13-42, C. 14, lines 19-20).

As per **Claims 6 and 16**, Leon fails to *explicitly* disclose wherein the visible marks and the non-visible marks are printed based on a *checksum* algorithm. However, Leon discloses one or more fields in the indicium can be encoded with a particular encryption algorithm (e.g., DES, RSA, or a *comparable algorithm*) or signed using a particular cryptographic or digital signature algorithm (e.g., DSA, RSA, or a *comparable algorithm*), or both (C. 11, line 63 – C. 12, line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Leon and include comparable algorithms, because it provides the system with a plurality of algorithms to process the postage information.

As per **Claims 7 and 17**, Leon further discloses wherein the visible marks and the non-visible marks comprise a bar code (C. 2, lines 35-46).

As per **Claims 8 and 18**, Leon further discloses wherein the visible marks and the non-visible marks comprise Information Based Indicia (IBI) (C. 7, lines 51-55).

As per **Claims 9 and 19**, Leon further discloses wherein the postage information includes a postage amount (See Figure 4).

As per **Claims 10 and 20**, Leon further discloses wherein the postage information includes a data, an origination address, a destination address, and security information (C. 12, lines 16-67; also see Figure 4).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY S. JABR whose telephone number is (571)272-1516.

The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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Please address mail to be delivered by the United States Postal Service (USPS) as follows:

**Commissioner of Patents and Trademarks
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or faxed to:

(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

/F. S. J./
Examiner, Art Unit 3628

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628